REMARKS

Claims 1-18 and 23-32 were pending in this application.

Claims 1-18 and 23-32 have been rejected.

Claims 1, 6, 11, 23 and 30-32 have been amended in this Response.

Claims 1-18 and 23-32 remain pending in this application.

Reconsideration of Claims 1-18 and 23-32 is respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 2, 4-12, 14-18 and 23-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,452,615 to Chiu *et al.* ("*Chiu*") in view of U.S. Patent No. 6,332,144 to deVries *et al.* ("*deVries*"). The Office Action rejects Claims 3 and 13 over *Chiu* and *deVries* in further view of U.S. Patent No. 6,285,361 to Brewer *et al.* ("*Brewer*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP §

2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. MPEP § 2142.

In rejecting Claim 1, the Examiner acknowledges that the *Chiu* reference does not teach a segment of a video by identifying segment starting point and endpoint boundaries. However, the Examiner asserts that the *deVries* reference teaches that items of audio or video media can be annotated by identifying the particular time or times within the period defined by the start and end times of a media stream forming an item of media. In rejecting Claim 5, however, the Examiner

further asserts that the *Chiu* reference discloses that the starting and endpoint of a segment is based on detecting meaningful changes of information in the audio and visual portions of the video before and after the selected frame. The Applicants respectfully submit that the cited prior art do not, in fact, teach identifying, in response to a bookmark signal, a starting point and endpoint of a segment containing a selected frame, where the starting point and endpoint of the segment are based on detecting meaningful changes of information in the audio, visual or transcript portion of the video other than a characteristic feature of the selected frame, as recited in amended independent Claim 1.

As the Examiner notes, the *Chiu* reference describes analyzing video from a rear projector containing presentation material to determine when slide changes occur. *See Chiu, col. 5, lines13-20; col. 7, lines 14-30.* However, the *Chiu* reference does not describe this analysis as occurring in response to user input. Instead, the analysis is an automatic background function, performed in order to provide meaningful index points into the video presentation.

In fact, such slide change index points are displayed independently of and distinct from user video 'snaps' and pen notations on the timeline of the *Chiu* notetaking system. *See Chiu, col. 5, lines 62-67.* The video snaps and pen notations are indicated by graphical icons and the slide change index points are indicated by dotted lines. As such, the Applicants respectfully submit that the *Chiu* reference describes a system in which slide changes are detected separately from and independently of any notetaking activity by a user of the system. Thus, the *Chiu* reference does not teach identifying, in response to a bookmark signal, a starting point and endpoint of a segment, as recited in Claim 1.

In a similar fashion, the *deVries* reference teaches a system for annotating media in which annotation clients analyze raw audio/video data to provide information about the audio/video data. *See deVries, col. 14, lines 1-12.* The independent annotation client produces an annotation sequence representing words that occur or speakers that are recognized. *See deVries, col. 14, lines 27-30.* Each annotation sequence begins with the first occurrence of the word or speaker, and ending with the last occurrence. *See deVries, Fig. 6; col. 14, lines 31-34.* Each annotation stream also has a start time and an end time, representing the locations in the audio/video data where the annotation sequence begins and ends, respectively. *See deVries, col. 16, lines 42-49.*

While annotation clients may be either automated processes or human annotators, the *deVries* reference describes annotation sequences constructed solely from occurrences of the word or speaker of interest. Thus, the Applicants respectfully submit that the *deVries* reference does not describe basing the starting point and endpoint of a segment upon the detection of meaningful changes of information in the audio, visual or transcript portion of the video other than a characteristic feature of a selected frame of a video, as recited in Claim 1.

As such, neither *Chiu* nor *deVries* describes a method of making segments of a video comprising identifying, in response to a bookmark signal. a starting point and endpoint of a segment containing a selected frame, where the starting point and endpoint of the segment are based on detecting meaningful changes of information in the audio, visual or transcript portion of the video other than a characteristic feature of the selected frame. Nor does the *Brewer* reference overcome this shortcoming of the *Chiu* and *deVries* references. Therefore, the *Chiu*, *deVries* and *Brewer*

references, either alone or in combination, do not disclose, suggest or hint at all the claim limitations of independent Claim 1 as amended. Independent Claims 11, 23 and 30-32 recite analogous limitations and therefore are also patentable over the cited prior art. Claims 2-4, 6-10, 12-14, 16-18 and 24-29 depend from Claims 1, 11 and 23 and contain the limitations of their respective base claims. The Applicant respectfully requests that the rejection of Claims 1-18 and 23-32 under 35 U.S.C. § 103(a) be withdrawn and that Claims 1-18 and 23-32 be passed to allowance.

III. CONCLUSION

For the reasons given above, the Applicant respectfully requests reconsideration and full allowance of all pending claims and that this application be passed to issue.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com.*

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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